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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,403	01/02/2002	Raymond W. Coles	41761-1002	8372
23562	7590	02/24/2004	EXAMINER	
BAKER & MCKENZIE PATENT DEPARTMENT 2001 ROSS AVENUE SUITE 2300 DALLAS, TX 75201			FUREMAN, JARED	
			ART UNIT	PAPER NUMBER
			2876	
DATE MAILED: 02/24/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/038,403

Applicant(s)

COLES, RAYMOND W.

Examiner

Jared J. Fureman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>09/29/2003</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Receipt is acknowledged of the IDS, filed on 9/29/2003, which has been entered in the file. Claims 1-22 are pending.

Priority

1. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification of in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)). The specific reference to any prior nonprovisional application must include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number.

Specification

2. The disclosure is objected to because of the following informalities: The specification does not contain headings. Headings, such as "BACKGROUND OF THE INVENTION", BRIEF SUMMARY OF THE INVENTION", "BRIEF DESCRIPTION OF THE DRAWINGS", and "DETAILED DESCRIPTION OF THE INVENTION", should be added to the specification.

Appropriate correction is required.

Claim Objections

3. Claims 6, 7, 14, and 18 are objected to because of the following informalities:

Claim 6, line 2: the third occurrence of "the" should be replaced with --an--, in order to avoid an appearance of a lack of proper antecedent basis for "the area".

Claim 7, line 2: "the" should be replaced with --a--, in order to avoid an appearance of a lack of proper antecedent basis for "a surface".

Claim 14:

Line 1, "the layer" lacks proper antecedent basis.

Line 3, "film" should be replaced with --material--, in order to be consistent with "plastics material" in line 1.

Claim 18, line 3: the first occurrence of "the" should be deleted, in order to avoid an appearance of a lack of proper antecedent basis for "the optical properties", and the third occurrence of "the" should be replaced with --a--, in order to avoid an appearance of a lack of proper antecedent basis for "the region".

Appropriate correction is required.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-5, 11-13 and 17, 18, 21, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baxendale (US 5,990,918, cited by applicants) in view of Lyszczarz (US 4,897,533, cited by applicants).

Baxendale teaches a method of forming an image and a printed item comprising: providing a substrate (4) and selectively depositing (using heater element 5 with various temperatures plastic material (7) over the substrate so as to form an image (7' or 10) therein; wherein the layer of plastics material is provided on a carrier film (see column 3 lines 8-13) and in which a plurality of heater elements (5) are provided on a thermal print head (1), and in which the heater elements are energized when the carrier film is in contact with the substrate to transfer the plastics material to the substrate (see column 3 lines 8-23); wherein the heater elements are energized to deposit a continuous layer of the plastics material over the whole of an area to be covered such that the plastics material serves as a protective coating (see column 3 lines 8-17); wherein selected regions (7') of the plastics material are heated to a greater degree than is necessary to deposit the plastics material so as to vary the surface appearance thereof (see column 3 lines 13-27); wherein the full thickness of the plastics film is deposited and selected portions thereof are overheated so as to give these portions a different appearance; wherein the overheated portions have a satin appearance; wherein the overheated portions have a matt appearance (see column 3 lines 28-40); wherein the image is printed over the substrate in a repeating pattern (as seen in figures 3 and 4, the regions 7' and 10 are formed in a repeating pattern); a surface printed in accordance with the method; wherein the layer of plastics material is deposited on the substrate during a printing process; wherein the item is an identity card, bank card, or credit card (see figures 1-4, column 1 line 10 - column 2 line 35, column 2 line 66 - column 3 line 40).

Baxendale fails to teach the substrate having at least one reflective region thereon and depositing a plastic material over the reflective region; the reflective region comprising a metal film; wherein the metal film is printed onto the substrate; wherein the metal film is provided on a carrier film and is brought into contact with the substrate at a printing station and transferred to the substrate.

Lyszczarz teaches a method and an item comprising: a substrate (2) having at least one reflective region (3) thereon and depositing a plastic material (4) over the reflective region; wherein the metal film is printed onto the substrate (the heat transfer of the foil 3 can be considered printing); wherein the metal film is provided on a carrier film (see column 4 lines 44-48) and is brought into contact with the substrate at a printing station (not shown, see column 4 line 41 - column 5 line 8) and transferred to the substrate (see figure 1-3, 5, 6, column 1 lines 13-19, column 1 line 57 - column 2 line 20, column 2 line 53 - column 3 line 6, column 3 lines 31-56, column 4 lines 1-10, column 4 line 41 - column 5 line 16, and column 5 lines 29-43).

In view of Lyszczarz's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the system as taught by Baxendale, the substrate having at least one reflective region thereon and depositing a plastic material over the reflective region; the reflective region comprising a metal film; wherein the metal film is printed onto the substrate; wherein the metal film is provided on a carrier film and is brought into contact with the substrate at a printing station and transferred to the substrate, in order to provide an attractive, distinctive appearance (see column 1 lines 13-19).

6. Claims 6-10, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baxendale as modified by Lyszczarz as applied to claims 1 and 18 above, and further in view of Louis (DE 296 22 711 U1, cited by applicants).

Baxendale as modified by Lyszczarz fails to specifically teach the substrate having an area/portions that are not covered by the reflective region.

Louis teaches a method and item including a substrate (14) having a reflective region/element (10), wherein the substrate has areas/portions that are not covered by the reflective region (see figure 2 and page 2 of the translation of the abstract).

In view of Louis's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the system as taught by Baxendale as modified by Lyszczarz, the substrate having an area/portions that are not covered by the reflective region, in order to utilize the reflective region/element to form additional images or security features.

7. Claims 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baxendale as modified by Lyszczarz as applied to claim 1 above, and further in view of Peyret (US 5,688,056, cited by applicants).

Baxendale as modified by Lyszczarz fails to specifically teach the image to be formed in the plastics film being held in a memory device readable by the printer, wherein the memory device is a removable memory device, wherein the image is held in an encrypted form.

Peyret teaches a system and method wherein an image (security mark) to be printed is held in a memory device (cartridge 104) readable by a printer (102), wherein

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the memory device is a removable memory device, wherein the image is held in an encrypted form (see figures 1, 2, column 3 lines 53-60, column 4 lines 15-21, 40-43, column 5 lines 16-33).

In view of Peyret's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the system as taught by Baxendale as modified by Lyszczarz, the image to be formed in the plastics film being held in a memory device readable by the printer, wherein the memory device is a removable memory device, wherein the image is held in an encrypted form, in order to provide greater security, thereby helping prevent fraudulent printing of the image.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jared J. Fureman whose telephone number is (571) 272-2391. The examiner can normally be reached on 7:00 am - 4:30 PM M-T, and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

February 20, 2004

Jared J. Fureman
JARED J. FUREMAN
PRIMARY EXAMINER